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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,202	04/04/2001	Uwe Wiedmann	14XZ00101	2591

7590 01/13/2004

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EXAMINER	
CHURCH, CRAIG E	
ART UNIT	PAPER NUMBER
2882	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/826,202	WIEDMANN, UWE	
	Examiner	Art Unit	
	Craig E. Church	2882	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 29 September 2003.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-60 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-60 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. While the disclosure teaches that an optical filter is provided whose absorption characteristics are set according to the output spectrum of a radiation intensifier (converter) which *spectrum is a function of the temperature of the intensifier,* there is absolutely no teaching that the light itself has a temperature or that the sensitivity of the detector is a function of temperature. Furthermore, the invention is directed to the behavior and performance of a radiation intensifier (wavelength converter) and is not enabling for light sources in general as in claims 1-28.

Claims 1-60 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the sp cification.

Claims 1-60 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 8, 14, 22, 25, 42-44 are obscure

since they do not specify that the temperature being referred to is that only of the light intensifier, itself. It is noted that light is not a tangible object and does not have a temperature. The limitations conveyed by "an energy content capable of shifting the temperature of the source" in claim 1; by "an energy content capable of shifting the temperature of the means for emission" in claims 2, 8, 14, 22, 25; by "a wavelength of the emission spectrum that has an energy content capable of generating a shift in temperature at the intensifier" in claim 45; by "the temperature of th means for intensifying responsive to the energy content of the emission spectrum" in claims 46 and 58-60 are unclear.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-60 are rejected under 35 U.S.C. § 103 as being unpatentable over Yamasaki et al (6242114). Yamasaki teaches

medical radiation detection means (lines 12-14 of column 1) for receiving radiation I comprising fluorescent layer 22, substrate 20 and filter 24 adjacent a detector (lines 33-36 of column 4). The filter is configured to control the emission of the fluorescent material in any way (lines 38-44 of column 4, 42-48 of column 8 and 47-52 of column 9) and may be in separate layers or may be integral with the fluorescent material. Lines 50-54 of column 2 explain that the invention eliminates thermal (temperature) deterioration of prior art systems. Yamasaki does not detail the structure of his detector, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ therefor any known type including photographic and electronic forms (claims 23 and 37-39).

Applicant's arguments filed September 29, 2003 have been fully considered, but they are not deemed to be persuasive.

There is absolutely no teaching in the original disclosure that the sensitivity of a detector is a function of temperature. Applicant may not claim subject matter that has not been originally disclosed, and this point of law cannot be overcome by argument. Where is this feature taught in the disclosure?. Even though applicant has referred to several sections of the disclosure, he has not pointed out where this feature is taught.

While it is true that the spectral output of an image intensifier is affected by its temperature, the concept that the spectral output of the intensifier somehow alters its temperature

is contrary to the principles of physics, and the phrases "an en rgy content capable of shifting the temperature of the source"; "an energy content capable of shifting the temperature of the means for emission"; "a wavelength of the emission spectrum that has an en rgy content capable of generating a shift in temperature at the intensifier" and "the temperature of the means for intensifying responsive to the energy content of the emission spectrum" are obscure and contrary to scientific logic. Paragraph 0030 referred to by applicant on page 17 of the amendment does not teach that the temperature of the intensifier is altered by its light output as alleged. Rather it states that the light output of the intensifier is affected by the temperature of the intensifier. If applicant maintains this position he is required to submit independent evidence of its accuracy.

The instant invention is directed to compensating for the change in the emission spectrum of a radiation intensifier *when the temperature of the intensifier changes*. This is explicitly stated in paragraphs 0020, 0021, 0022, 0030 and 0035 of the specification, and this is what should be claimed. There is absolutely no teaching that the light itself has a temperature or that the sensitivity of the detector is a function of temperature as claimed. Furthermore, the invention is directed to the behavior and performance of a radiation intensifier (wavelength converter) and is not enabling for light sources in general.

Applicant mischaracterizes the rejection in stating:

> The examiner alleges that Yamasaki teaches medical radiation detection means that control the emission of the fluorescent material and that eliminates thermal deterioration of prior art systems.

The actual rejection may be found above. Applicant's reference to In re Fine is not germane since the metes and bounds of the instant claims are in the twilight zone, and a reasonable comparison of thereof to the prior art is hopeless.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

> A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner Church at telephone number (703) 308-4861.

Craig E Church

CRAIG E. CHURCH
Senior Examiner
ART UNIT 2882